

REMARKS

Interview

Applicants would like to thank Examiner Dickinson and Primary Examiner Silverman for the telephone conference with Applicants' representative on April 15, 2009. During the telephone conference, the differences between U.S. Patent 5,556,580 and the present was discussed and claim amendments to overcome U.S. Patent 5,277,914 were also discussed. The Examiner agreed to consider the arguments and amendments when submitted in writing.

Status of the Claims

Claims 1, 3-15, and 17-22 are currently pending and under examination. Claims 2 and 16 have been canceled without prejudice or disclaimer of the subject matter claimed therein. New claim 22 has been added.

Amendments to the Claims

Claim 1, 7, and 17 have been amended.

Representative support for the amendment to claim 1 can be found in claim 7 as originally filed.

Claim 7 has been amended to delete the feature that has been added to claim 1.

Claim 17 has been amended to delete the feature that is in new claim 22.

Representative support for new claim 22 can be found in claim 17 as originally filed.

Claims 9, 10, and 19-21 have been amended to correct typographical errors.

The amendments to the claims do not add prohibited new matter.

Rejections under 35 U.S.C. 102(b)

A. Claims 1, 3-7, 9-15, 17, and 18 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent 5,556,580 ("‘580").

B. Claims 19-21 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent 556,580. It is respectfully submitted that the Office Action made a typographical error, as U.S. Patent 556,580, which is issued in 1896, is not distinguished in the Office Action from the ‘580 patent. In the following remarks, Applicants assume that claims 19-21 are rejected as allegedly being anticipated by ‘580.

The Office Action alleges that the ‘580 patent discloses the claimed invention. It is respectfully submitted that the ‘580 patent does not disclose extruding an amphiphilic component as in step (a) of the claimed invention, and subsequently dispersing the extruded component in an aqueous medium as in step (b) of the claimed invention. As discussed during the phone conference, the ‘580 patent does not teach dispersing an extruded composition in an aqueous medium to form liposomes (See ‘580 patent at Examples 1-4).

Moreover, the Examples of the ‘580 patent discloses forming liposomes using organic solvents. Thus, the ‘580 patent does not disclose the nanoparticles as claimed in claim 17.

Further, Applicants respectfully submit that the range of 0.1mm to about 2mm, as recited in claim 18, should not be interpreted to include the size disclosed in the ‘580 patent of 5mm. 5mm is a 250% increase in bore size over the cited maximum of about 2mm. Accordingly, the bore size ‘580 patent is far larger and cannot be reasonably interpreted to be “about” the same size.

Accordingly, the ‘580 patent does not disclose every element of the claimed method. It is therefore respectfully requested that this rejection be withdrawn.

B. Claims 1 and 3-21 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent 5,277,914 (“‘914”).

The Office Action alleges that the ‘914 patent discloses producing homogenous nanoparticles comprising the extrusion and dispersion steps of the claimed method. It is respectfully submitted that claim 1, as amended, requires that the extrusion be performed in a solution without an organic solvent. The ‘914 patent discloses extrusion in an organic solvent or in an aprotic solvent which is an organic solvent (*see, e.g.*, Col. 5, Section 1 of the ‘914 patent). Accordingly, the ‘914 patent does not anticipate the claimed invention. It is therefore respectfully requested that this rejection be withdrawn.

Rejection under 35 U.S. C. § 103(a)

Claim 8 is rejected under 35 U.S.C. § 103(a) as allegedly being obvious in view of the ‘580 patent.

The deficiencies of the ‘580 patent are discussed above. In view of the above arguments, claim 1, as amended, is not anticipated by the ‘580 patent. Accordingly, the ‘580 patent does not disclose every element of claim 8 because claim 8 depends from claim 1 and includes all the

features of claim 1. Thus, it is believed that claim 8 is not obvious over the '580 patent. It is therefore respectfully requested that this rejection be withdrawn.

Conclusion

The foregoing amendments and remarks are being made to place the application in condition for allowance. Applicant respectfully requests entry of the amendments, reconsideration, and the timely allowance of the pending claims. A favorable action is awaited. Should the Examiner find that an interview would be helpful to further prosecution of this application, she is invited to telephone the undersigned at her convenience.

If there are any additional fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Date: **April 23, 2009**
Morgan, Lewis & Bockius LLP
Customer No. **09629**
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
Tel: 202-739-3000
Fax: 202-739-3001

Respectfully submitted,
Morgan, Lewis & Bockius LLP

/Sally Teng/

Sally P. Teng
Registration No. 45,397